

REMARKS

This responds to the Office Action mailed on March 23, 2006, and the references cited therewith. By this amendment, claims 1 and 14 have been amended. No claims have been added or canceled. As a result, claims 1-14 remain pending in this application.

§103 Rejection of the Claims

A. Rejection: Claims 1-8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hershey (U.S. Patent No. 5,867,963) in view of Zusman (U.S. Patent No. 4,156,995).

B. Response: In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1, as now amended, recites "...an openwork web structure joining said chords; said web structure comprising a series of connector members formed of inclined branches and adhesively secured to said lower and upper chords; each said inclined branch of said connector members ... having adjacent side edges adhesively joined to one another...the adjacent side edges of the at least two planks defining a plane crossing the substantially parallel planes of the elongated lower chord and the elongated upper chord at an angle other than substantially perpendicular." The Examiner admitted in the previous Office Action dated January 3, 2005 (see page 3) that Hershey does not teach each said inclined branch of said connector members being formed of at least two planks each having a rectangular cross-section including opposite

side faces and opposite side edges and having adjacent side edges adhesively joined to one another." (emphasis added). In the current Office Action (dated March 23, 2006) the Examiner again admits that Hershey is "...is silent with regards to how his connector members are joined." The Examiner then relies on Zusman for teaching "...that it is known in the art to adhesively secure two connector members (17) along the ends." (See page 3 of the March 23, 2006 Office Action). However, an electronic search of the Zusman reference on the USPTO's own web site fails to yield any result for the term adhesive in the Zusman reference. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references cited by the Examiner simply fail to teach or suggest all the claim limitations.

The Zusman reference does mention the term "join" as set forth in the following paragraph:

Referring to FIG. 1 of the drawings, it will be seen that the truss members 11B and 12B are preferably made of **three separate truss units** formed of two by fours **joined together** to form a basic cross support across the foundation wall 14. The tie-down straps 13 are placed on either side of the truss intersections along the perimeter of the foundation wall 14 to help secure the cantilevered truss construction 10 to the foundation wall 14. The truss members 12A and 12B are preferably made of **two separate truss units** formed of two by fours **joined together**. (See column 2, lines 29-39 of the Zusman reference—emphasis added)

The Zusman reference, therefore, also fails to meet the language of claim 1 which requires "A structural wooden joist comprising: a) an elongated lower chord; b) an elongated upper chord ... and c) an openwork web structure joining said chords; said web structure comprising a series of connector members formed of inclined branches...each said inclined branch of said connector members being formed of at least two planks each having a rectangular cross-section..." Zusman acutally teaches ganging two separate truss units, or three separate truss units together. Each separate truss unit of Zusman teaches inclined branches having a single plank between the upper and lower chords of the truss. Therefore, Zusman also fails to teach or suggest the language of claim 1.

Even if Zusman could be interpreted to meet the language set out in the immediately preceding paragraph, Zusman fails to teach the orientation of the at least two planks as now claimed. The planks of the inclined branches have adjacent sides which form a plane that is perpendicular to the planes of the upper chord and the lower chord. Therefore, the structure

shown in Zusman does not teach or suggest that the adjacent side edges of the at least two planks define a plane crossing the substantially parallel planes of the elongated lower chord and the elongated upper chord at an angle other than substantially perpendicular, as recited in claim 1.

In fact, the Zusman reference teaches away from this limitation. Zusman teaches forming separate truss units and then ganging them. Zusman would have to assemble the resulting truss units in a totally different way which would be much more complex than ganging several separate truss units together. This teaching away is evidence against a reason to combine Zusman and Hershey to yield applicant's invention. For the reasons set forth above, claim 1 overcomes the Examiner's rejection under 35 USC § 103(a) as being unpatentable over Hershey (U.S. Patent No. 5,867,963) in view of Zusman (U.S. Patent No. 4,156,995).

Claims 2-8 depend, either directly, or from claim 1 and include the limitations of claim 1 by their dependency. As a result, applicant believes that the Examiner's rejection of claims 2-8 are now also improper for the reasons set forth above with respect to claim 1.

Claim 14 recites "A structural wooden joist, comprising: a first elongate chord; a second elongate chord spaced apart from the first chord; a web structure joining the first chord and the second chord and forming openings between the first chord and the second chord, the web structure including a series of **V-shaped arrangements comprising two connector members, each connector member comprising a first plank and a second plank**, the first plank having a first side, a first end, and a second end, second plank having a second side, a third end and a fourth end, **the first side being adhesively secured to the second side**, the first and third ends being adhesively secured to the first chord, and the second and fourth ends being adhesively secured to second chord, wherein **the first side and the second side define a plane crossing the first elongate chord and the second elongate chord at an angle other than substantially 90 degrees.**" (Emphasis added). The combination of Hershey and Zusman fail to make out a proper *prima facie* case of obviousness. Neither Hershey nor Zusman teach or suggest adhesively bonding the first side of the first plank and the second side of the second plank, as recited in claim 14. In addition, Zusman teaches ganging either two separate truss members or three separate truss members to form a cantilevered cross truss construction. Each separate truss uses a single plank for the connector members of the v-shaped arrangements rather than a first plank and a second plank. Even if one was to somehow interpret Zusman to include

the two planks per connector member, the planks are not orientated so that **first side and the second side define a plane crossing the first elongate chord and the second elongate chord at an angle other than substantially 90 degrees**, as recited in claim 14. The Hershey reference teaches that multiple members can be used, but does not show or teach any orientation, much less the orientation set forth in claim 14. Accordingly, claim 14 now overcomes the Examiner's rejection under 35 USC § 103(a) as being unpatentable over Hershey (U.S. Patent No. 5,867,963) in view of Zusman (U.S. Patent No. 4,156,995).

C. Rejection: Claims 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hershey (U.S. Patent No. 5,867,963) in view of Zusman (U.S. Patent No. 4,156,995).

D. Response: Claims 2-13 depend, either directly, or from claim 1 and include the limitations of claim 1 by their dependency. As a result, applicant believes that the Examiner's rejection of claims 2-13 are now also improper for the reasons set forth above with respect to claim 1.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of August 2006.

PATRICIA A. HULTMAN

Name

Signature

